

Applicant: S Watanabe
U.S.S.N.: 10/019,747
Response to Office Action
Page 21 of 33

REMARKS

Applicant appreciates the Examiner's thorough examination of the subject application and requests reconsideration of the subject application based on the foregoing amendments and the following remarks.

Claims 34-57 are pending in the subject application. Claims 1-33 were previously canceled.

Claims 34-36, 40, 42, 43, 45, 47, 48, 50-55 and 57 stand rejected under 35 U.S.C. §102, and/ or 35 U.S.C. §103. Claims 37-39, 41, 44, 46, 49 and 56 were objected to as depending from a rejected base claim, however, the Examiner indicated that the claims would be allowable if appropriately re-written in independent form.

Claims 34 and 47 were amended to clarify that the summary information is statistics of motion picture data included in the spatially split blocks. Claims 51 and 54 also were amended for clarity so as to more clearly describe the spatially split blocks.

Claim 37 was re-written so as to be in independent form as suggested by the Examiner.

Claims 58-70 were added to more distinctly claim embodiments and aspects of the present invention.

The amendments to the claims are supported by the originally filed disclosure.

35 U.S.C. §102 REJECTIONS

The Examiner rejected claims 34, 36, 51 and 54 under 35 U.S.C. §102(e) as being anticipated by Yang et al. [USP 5,819,286; “Yang”]. Applicant respectfully traverses as discussed below. Because claims were amended in the instant amendment, the following discussion refers to the language of the amended claims. However, only those amended features specifically relied upon to distinguish the claimed invention from the cited prior art shall be considered as being made to overcome the cited reference.

Applicant claims, claim 34, a motion picture retrieval information generating apparatus that generates retrieval information for retrieving motion picture data constituted of one or more scenes. Such a motion picture information generating apparatus includes a retrieval information generating section that generates retrieval information corresponding to each of said one or more scenes on the basis of said motion picture data.

The retrieval information generating section also includes a first summary information generating means. The first summary information generating means forms plural spatially split blocks of a scene which are obtained by spatially splitting said scene and which have a length of said scene in a direction of the time axis and generates summary information of said scene generated by calculating statistics of motion picture data within each of said spatially split blocks of said scene.

Yang is apparently being construed in the Office Action such that a frame (or time) at which a particular icon appears in a scene and a block position are obtained as search

information, and this apparently is being interrupted to be the same as the summary information of the rejected claim. The foregoing amendment to claim 34, more particularly the spatially split block description therein, was made to advance prosecution and to more particularly clarify that the summary information is formed of statistics of motion picture data included in the spatially split blocks of a scene respectively. In contrast, the search information in Yang is not statistics. Thus, the present invention is distinguishable from Yang at least for this reason.

It is respectfully submitted therefore, that at least because of the dependency from a base claim that is considered to be allowable, claim 36 is thus considered to be distinguishable from Yang.

As to claim 51, Applicant claims a storage medium in which retrieval information for retrieving motion picture data constituted of one or more scenes is stored together with correspondence information between the retrieval information and the motion picture data. The retrieval information being stored therein includes summary information being statistics of motion picture data with spatially split blocks of said one or more scenes. The split blocks of a scene are obtained by spatially splitting said scene and have a length in a direction of the time axis.

In addition to the comment above regarding claim 34, Applicants make the following further observations. Such spatially split blocks are not described anywhere in Yang. In Yang, the video is converted to symbolic data and pattern recognition may be performed to identify specific icons in the video. See col. 6, lines 10-15 thereof. It also is described therein that the

Applicant: S Watanabe
U.S.S.N.: 10/019,747
Response to Office Action
Page 24 of 33

processor records the symbols including the coordinates of the symbols and illustratively constructs a video index base such as shown in Table 1 in Yang. See col. 6, lines 36-60 thereof.

In sum, Yang describes the creation of a video index table. Yang, however, does not describe nor teach a storage medium comprising retrieval information for retrieving motion picture data that includes summary information that is statistics of motion picture data in spatially split blocks of said one or more scenes. Nor that the plural split blocks for a scene are obtained by spatially splitting said scenes and so as to have a length in a direction of the time axis.

Applicant respectfully submits that the foregoing remarks distinguishing claim 51 from Yang also apply to at least distinguish the motion picture retrieval information managing apparatus of claim 54 from Yang.

As provided in MPEP-2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Or stated another way, “The identical invention must be shown in as complete detail as is contained in the ... claims. *Richardson v Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ 2d. 1913, 1920 (Fed. Cir. 1989). Although identify of terminology is not required, the elements must be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990). It is clear from the foregoing remarks that the above identified claims are not anticipated by the cited reference.

Applicant: S Watanabe
U.S.S.N.: 10/019,747
Response to Office Action
Page 25 of 33

It is respectfully submitted that for the foregoing reasons, claims 34, 36, 51 and 54 are patentable over the cited reference and thus satisfy the requirements of 35 U.S.C. §102(e). As such, these claims, including the claims dependent therefrom are allowable.

35 U.S.C. §103 REJECTIONS

Claims 34, 35, 36, 40, 42, 43, 45, 47, 48, 50-56 and 57 stand rejected under 35 U.S.C. §103 as being unpatentable over the cited prior art for the reasons provided on pages 4-6 of the above-referenced Office Action. Because claims were amended in the foregoing amendment, the following discussion refers to the language of the amended claim(s). However, only those amended features specifically relied on in the following discussion shall be considered as being made to overcome the prior art reference. The following addresses the specific rejections provided in the above-referenced Office Action.

CLAIMS 34, 36, 40, 42, 43, 45, 47, 48, 50-55 & 57

Claims 34, 36, 40, 42, 43, 45, 47, 48, 50-55 and 57 stand rejected as being unpatentable over the MPEG Compressed Video by Kobla et al. [“Kobla”] for the reasons provided on pages 4-5 of the above referenced Office Action. Applicant respectfully traverses.

As indicated in the discussion above regarding the §102 rejection of claim 34, claim 34 was amended to clarify the claimed spatially split blocks, more particularly to clarify that the summary information is formed of statistics of motion picture data included in the spatially split

blocks of a scene respectively. It is respectfully submitted that Kobla does not describe, teach nor suggest the foregoing as well. It also is respectfully submitted that Kobla does not teach, suggest nor provide any motivation for modifying the disclosures therein so as to yield the apparatus being claimed by Applicant. Thus, Applicant respectfully submits that claim 34 is patentable over Kobla.

It also is respectfully submitted that at least because of the dependency from a base claim that is considered to be allowable, claims 36, 40, 42, 43 and 45 also are considered to be allowable.

Applicant claims, claim 47, a motion picture retrieving apparatus for retrieving a desired picture using retrieval information corresponding to each of one or more scenes constituting motion picture data, where such motion picture data is related with said retrieval information that comprises summary information for each of said one or more scenes. Such a motion picture retrieving apparatus includes information managing means for reading and managing said retrieval information and first scene retrieving means. The first scene retrieving means is being connected with said information managing means, and is for retrieving a scene meeting a first retrieval request in response to said first retrieval request with a scene as a retrieval unit, provided from the outside, using said summary information included in the retrieval information. Further, the summary information is statistics of motion picture data within spatially split blocks of said one or more scenes, the spatially split blocks of a scene are obtained by spatially splitting said scene and have a length of said scene in a direction of the time axis.

In addition to the foregoing remarks regarding claim 34, Applicants makes the following further observations. As admitted in the Office Action, the disclosure in Kobla is directed to a system/ apparatus in which a key frame is selected that is representative of the scene. There is no discussion anywhere in Kobla of spatially splitting the scene including all frames of the scene and so that there is one spatially split block for each scene that represents all of the corresponding split blocks of the frames for that scene.

As to the suggestion that it would have been obvious to one skilled in the art that using the idea method for selecting key frames as taught in Kobla would be used to obtain a summary frame, does not agree with the general principle that a modification is not obvious if the suggested modification to an apparatus destroys the intended purpose or function of the apparatus described in the reference. As provided by the Federal circuit, a 35 U.S.C. §103 rejection based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in a reference, is not proper and the *prima facie* case of obviousness cannot be properly made. In short there would be no technological motivation for engaging in the modification or change. To the contrary, there would be a disincentive. *In re Gordon*, 733 F. 2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In the present case it is clear that if Kobla was modified in the suggested fashion, that the resultant apparatus would be incapable of operating in the manner described and taught in Kobla. Namely, the intend purpose and function in Kubola, as acknowledged in the Office Action, is to identify and select a key frame for indexing not to try and combine or aggregate the information in corresponding spatially split blocks of all the frames that make up a scene.

Applicant: S Watanabe
U.S.S.N.: 10/019,747
Response to Office Action
Page 28 of 33

Each of claims 48 and 50 depend directly from claim 47. Thus, and at least because of the dependency from a base claim that is considered to be allowable, each of claims 48 and 50 are considered to be allowable.

Applicant respectfully submits that the foregoing remarks regarding claims 47 as well as the remarks above directed to claim 51 in regards to the §102 rejection of this claim, also at least apply to distinguish each of each claims 51-55 and 57 from the cited reference.

It is respectfully submitted that claims 34, 36, 40, 42, 43, 45, 47, 48, 50-55 and 57 are patentable over the cited reference(s) for the foregoing reasons.

CLAIM 35

Claim 35 stands rejected as being unpatentable over Yang et al. [USP 5,819,286; “Yang”] in view of Coleman [USP 5,778,108] for the reasons provided on page 6 of the above referenced Office Action. Applicant respectfully traverses.

As indicated above claim 34 is considered to be in allowable form. Thus, and at least because of the dependency from a base claim that is considered to be allowable, claim 35 is considered to be allowable.

Applicant also makes the following further observations regarding Coleman. As indicated in the discussion above regarding the §102 rejection of claim 34, claim 34 was amended to clarify the claimed spatially split blocks, more particularly to clarify that the summary information is formed of statistics of motion picture data included in the spatially split

Applicant: S Watanabe
U.S.S.N.: 10/019,747
Response to Office Action
Page 29 of 33

blocks of a scene respectively. It is respectfully submitted that Coleman does not describe, teach nor suggest the foregoing as well. It also is respectfully submitted that Coleman does not teach, suggest nor provide any motivation for modifying the disclosures of Yang so as to yield the apparatus being claimed by Applicant. Thus, Applicant respectfully submits that claim 34 is patentable over the combination of Yang and Coleman.

It is respectfully submitted that claim 35 is patentable over the cited reference(s) for the foregoing reasons.

The following additional remarks shall apply to each of the above.

As provided in MPEP 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F. 2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F. 2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). As provided above, the references cited, alone or in combination, include no such teaching, suggestion or motivation.

Furthermore, and as provided in MPEP 2143.02, a prior art reference can be combined or modified to reject claims as obvious as long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 19866). Additionally, it also has been held that if the proposed modification or combination would change the principle of operation of the prior art invention being modified, then the teachings of the references are not

Applicant: S Watanabe
U.S.S.N.: 10/019,747
Response to Office Action
Page 30 of 33

sufficient to render the claims *prima facie* obvious. Further, and as provided in MPEP-2143, the teaching or suggestion to make the claimed combination and the reasonable suggestion of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As can be seen from the forgoing discussion regarding the disclosures of the cited reference(s), there is no reasonable expectation of success provided in the reference(s). Also, it is clear from the foregoing discussion that the modification suggested by the Examiner would change the principle of operation of the apparatus disclosed in Kobla.

It is respectfully submitted that for the foregoing reasons, claims 34, 35, 36, 40, 42, 43, 45, 47, 48, 50-56 and 57 are patentable over the cited reference(s) and thus satisfy the requirements of 35 U.S.C. §103. As such, these claims are allowable.

CLAIMS 37-39, 41, 44, 46, 49 & 50

In the above-referenced Office Action, claims 37-39, 41, 44, 46 49 and 50 were objected to as being dependent upon a rejected base claim. It also was provided in the above-referenced Office Action, however, that these claims would be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claim(s).

Claim 37 was re-written in the foregoing amendment so as to be in independent form and to include all the limitations of the base claim there being no intervening claim(s). Accordingly, claim 37 is considered to be in allowable form.

Applicant: S Watanabe
U.S.S.N.: 10/019,747
Response to Office Action
Page 31 of 33

As to claims 38-39, 44 and 46, these claims were not re-written in independent form as suggested by the Examiner. Applicant, however, reserves the right to later amend the subject application so as to present any one or more of these claims in independent form or to add one or more independent claims that contain the limitations of any one or more of claims 38-39, 44 and 46.

In as much as Applicant believes that the related base claims are in allowable form, claims 41, 49 and 50 were not re-written in independent form as suggested by the Examiner. Applicant, however, reserves the right to later amend the subject application so as to present any one or more of these claims in independent form or to add one or more independent claims that contain the limitations of any one or more of claims 41, 49 and 50.

CLAIMS 58-70

As indicated above, claims 58-70 were added to more distinctly claim embodiments of the present invention. These claims, as provided below, are clearly supported by the originally filed disclosure, including the originally filed claims. It also is respectfully submitted that these added claims are patentable over the cited prior art on which the above-described rejection(s) are based.

Applicant: S Watanabe
U.S.S.N.: 10/019,747
Response to Office Action
Page 32 of 33

OTHER MATTERS

A Supplemental Information Disclosure Statement (IDS) dated December 21, 2004, was filed by Applicant, which IDS post-dates the above-referenced Office Action. Accordingly, Applicant respectfully requests that the Examiner reflect their consideration of this IDS in the next official communication from the USPTO. Applicant also respectfully requests the Examiner to call the undersigned collect and the below number in the event that this IDS has not been received by the Examiner and thus needs to be again submitted by Applicants for the Examiner's consideration.

It is respectfully submitted that the subject application is in a condition for allowance. Early and favorable action is requested.

Because the total number of claims and/or the total number of independent claims post amendment now exceed the highest number previously paid for, a check is enclosed herewith for the required additional fees. However, if for any reason a fee is required, a fee paid is inadequate

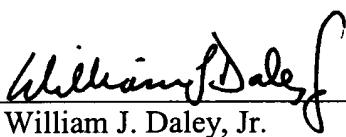
Applicant: S Watanabe
U.S.S.N.: 10/019,747
Response to Office Action
Page 33 of 33

or credit is owed for any excess fee paid, the Commissioner is hereby authorized and requested to charge Deposit Account No. **04-1105**.

Respectfully submitted,
Edwards & Angell, LLP

Date: May 17, 2005

By:



William J. Daley, Jr.
(Reg. No. 35,487)
P.O. Box 55874
Boston, MA 02205
(617) 439- 4444

Customer No. 21,874

Bos2_473841.1